



20 JUL 2006

Jeffrey J. Sopko
Pearne & Gordon, LLP
1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108

In re Application of	:	
TAKAMORI, et al.	:	
Application No.: 10/531,437	:	DECISION ON PETITION
PCT No.: PCT/JP03/13201	:	
Int. Filing Date: 15 October 2003	:	UNDER 37 CFR 1.497(d)
Priority Date: 15 October 2002	:	
Atty. Docket No.: 38131	:	
For: PORTABLE TYPE ELECTRONIC APPARATUS	:	

This decision is in response to applicant's correspondence filed 07 June 2006 in the United States Patent and Trademark Office (USPTO). The submission of a declaration listing less than all of the inventors on the published international application is being treated as a request under 37 CFR 1.497(d).

BACKGROUND

On 15 October 2003, applicant filed international application PCT/JP03/13201, which claimed priority of an earlier application filed 15 October 2002. A copy of the International Application was forwarded to the USPTO from the International Bureau (IB) on 29 April 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 15 April 2005.

On 14 April 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an Information Disclosure Statement; an English translation of the international application and a First Preliminary Amendment.

On 30 December 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 23 March 2006, applicant filed a declaration executed by joint inventors Kazuaki Takamori, Kenichi Nishikawa, Teruo Nanmoku, Muneoki Kamata and Hidehiro Yanagibashi

accompanied by authorization to charge any necessary extension of time payments.

On 15 May 2006, applicant was mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) informing applicant that the filed declaration did not comply 37 CFR 1.497 (a) and (b) since not all of the inventors from the published international application were listed on the declaration. Thus the filing was not a proper response to the Form PCT/DO/EO/905 mailed 30 December 2005. Applicant was afforded one month from the mailing of the Form PCT/DO/EO/916 or within the time remaining in the response set forth in the Form PCT/DO/EO/905, whichever was longer.

On 07 June 2006, applicant filed the present correspondence which is being treated as a petition under 37 CFR 1.497(d).

DISCUSSION

Applicant states that, "enclosed is a Supplemental Application Data Sheet showing the **revised** inventorship according to the enclosed Declaration and Power of Attorney." (Boldness added). The paper is being treated under 37 CFR 1.497(d).

37 CFR 1.497(d) [formally, 37 CFR 1.48] states in part: "If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application....applicant must submit:

- (1) a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) the fee set forth in 37 CFR 1.17(i); and
- (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b); and
- (4) any new oath or declaration required by paragraph (f) of this section.

Applicant has authorized the charging of the \$130.00 petition fee to deposit account number 16-0820 thus satisfying item (2). Items (1) and (3) have not been satisfied.

Regarding item (4), it is unclear whether this item has been satisfied as applicant has submitted the same declaration as filed on 23 March 2006. Applicant has not provided an explanation as to why inventors Noriyashi Sato, Kazunori Sato, Takeshi Sato and Satoshi Kosugi are not listed as inventors. It is assumed that they were mistakenly listed on the international application. If in fact they were correctly listed in the PCT Request form and are now being removed because of a change in the claims, applicant should proceed pursuant to 37 CFR 1.48.

It is noted that the filing of a petition under 37 CFR 1.48(b) is not applicable prior to the application being executed by all the named inventors. Under 35 U.S.C. 363, an international application designating the United States has the effect of a national application for a patent regularly filed in the United States. In other words, the U.S. national stage application is considered to have been filed on the international filing date in the names of the inventors/applicants for the United States of America listed on the REQUEST form.

37 CFR 1.48(f)(1), by its terms, applies only to a non-provisional application filed under 37 CFR 1.53(b). (See also, 37 CFR 1.9(a)(3)). A national application resulting from an international application entering the national stage under 37 U.S.C. 371 is not an application filed under 37 CFR 1.53(b), but an application that has entered that national stage under 37 CFR 1.494 or 1.495.

Accordingly, the requirements under 35 U.S.C. 371(c)(4) must be met, namely, that an oath or declaration of the inventors complying with the regulations for oaths or declaration of applications be filed. As set forth in 37 CFR 1.497, the oath or declaration must be executed by all the inventors.

CONCLUSION

For the reasons above, applicant's request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file any request for reconsideration. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459